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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,628	03/19/2001	Jean-Christophe Henrion	05725.0868-00	7362

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/14/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

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Applicant(s)

HENRION ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted March 3, 2003 is acknowledged.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sartori (of record) in view of Gaydos (of record).

3. As stated in the prior office action, Sartori teaches various halogen substituted dinaphthofurandiones, including position isomer of the elected species herein, as dyes. See prior office action.

Sartori does not teach expressly the employment of the compounds in the well-known cosmetic products herein, or the particular cosmetically acceptable medium.

As stated in the prior office action, Gaydos teaches colored flock for various cosmetic compositions. See the prior office action. Gaydos further teaches expressly the flock is to be incorporated with a composition comprising film-forming polymer. See, col. 2, lines 1-28.

As discussed in the prior office action, it would have been prima facie obvious to one of ordinary skill in the art, at the time the invention was made to have used polyester fibers dyed with the compounds of Sartori in cosmetic compositions as taught by Gaydos in order to benefit

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from polyester fibers in various colors with bright, strong color of good sublimation fastness as taught by Sartori.

Response to the Arguments

Applicants' amendments and remarks submitted March 3, 2003 have been fully considered, they are persuasive to the rejection over Cheng et al., but are not persuasive with respect to the rejection set forth above for reasons discussed below.

Applicants have not disputed that the elected compound is a position isomer of a known compound having the same property and utility herein, but argue a position isomer is not obvious over a known compounds, citing Ex Parte Mowry, Ex Parte Hogg and Jackson, and In re Grabiak. Applicants have misused the two cases. Particularly, in Ex Parte Mowry, the isomer passes unobvious properties over the known compounds. In Ex parte Hogg and Jackson, the claimed isomer have different utility from the known compounds. (claim a primary alcohol for synthetic intermediate, known compound is a tertiary alcohol). In re Gradiak involves different substituents, not position isomer. In fact, the court states "Fact that position isomer of compound is known is some evidence of obviousness of compound; position isomerism is fact of close structural similarity which is taken into consideration with all other relevant facts in applying test of obviousness under 35 U.S.C. 103;" In re Metha (CCPA) 146 USPQ 284. The claimed compounds herein and the compound disclosed by Sartori have the same utility, no unexpected property.

Applicants' argue that to reach the instant claims one of ordinary skill in the art would have to make several selection. Note, as stated in the prior office action, the selection of a known

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material based on its suitability for its intended use has been determined to be prima facie obvious. The dyed polyester flock taught by Gaydos is expected to be similarly useful as other flocks disclosed therein, there is no issue of picking and choosing.

No claim is allowable.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner

SHENGJUNWANG
PATENT EXAMINER

Shengjun Wang

May 10, 2003